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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,204	07/31/2001	Hideyuki Aoki	FUJH 18.876	3969
26304 7590 07/21/2009 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER				
LIN, WEN TAI				
ART UNIT		PAPER NUMBER		
2454				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/919,204

Applicant(s)

AOKI ET AL.

Examiner

Wen-Tai Lin

Art Unit

2454

Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7-11,13-15,18,21,22,24-26,28,29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7,9-11,13-15,18,21,22,24-26,28,29 and 31 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 5, 7-11, 13-15, 18, 21-22, 24-26, 28-29 and 31 are presented for examination.
2. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

Claim Rejections - 35 USC § 102

3. Claims 21-22, 24-26, 28-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Sheridan [U.S. Pat. No. 5760917].
4. Sheridan was cited in the previous office action.
5. As to claims 21, 25 and 29, Sheridan teaches a server/method/terminal to distribute information [e.g., Figs. 1-2 and 6], comprising:

a communication unit [i.e., an inherent feature to Hub station 20, Fig.6] configured to receive a request including access destination information from a first terminal [e.g., 40A, Fig.6; note that the first terminal is the user who had stored or processed images at Hub 21, Fig. 6 who may arrange various sharing groups (as listed in Fig. 2) at Hub 20] and distributing information to a plurality of terminals [e.g., col.4, lines 17-33]; and a processor controlling the

communication unit to access to a content server [e.g., Hub station 21, Fig.6, wherein low-resolution images are previously stored (col. 5, lines 19-64)] and obtain the information by using the access destination information [e.g., the selected email list] upon receiving of the request and to control the communication unit to distribute the information obtained from the content server to the plurality of terminals including a second terminal without receiving a request to receive the information from the second terminal [col.13, lines 13-42; note that any of the users on Fig. 2 can be the second terminal and the low-resolution images are contained in the distribution emails].

6. As claims 22 and 26, Sheridan teaches that the method further comprising storing the information in a storing unit and deleting the stored information after completion of the information distribution [e.g., col.3, lines 8-15; note that the “information” here is related to the access rights].

7. As to claims 24, 28 and 31, Sheridan further teaches that the access information identifies the content server and indicates data location in the content server [e.g., col.13, lines 28-41; it is further noted that a provider’s content database is typically organized with keys that specific content can be retrieved by specifying the name of a content which a user provides in the request].

8. Claims 1, 5, 9-11, 14-15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheridan [U.S. Pat. No. 5760917].

9. Sheridan was cited in the previous office action.

10. As to claim 1, Sheridan teaches the invention as claimed including: an information distribution device [e.g., Hub B, Fig.6] which is connected with a plurality of terminal devices [e.g., 40A – 40C, Fig.6] which belong to a group, and a content server storing distribution information via a network [e.g., Hub A, Fig. 6; col.13, lines 13-42] using an IP protocol, said information distribution device, comprising:

a first storage portion storing terminal information including addresses each identifying a terminal device belonging to said group, on the network using IP protocol [Figs. 1-2, col.4, lines 17-33, wherein a user may designated a group of (third party) terminal devices to whom the photographs would be shared; note that each email address is associated with an email provider's IP address];

a first receiving portion receiving, from one terminal device belonging to said group [e.g., 202, Fig.1], a distribution request including a Uniform Resource Location as access information [e.g., col. 5, lines 23-27], which is required for accessing the distribution information stored in the content server and distribution destination information specifying addresses on the network of other terminal devices that the one terminal device which belong to said group and to which the distribution information is to be distributed [col.4, lines 48-67; col.5, lines 7-18; col.13, lines 13-42];

a second receiving portion accessing said distribution information stored in a content server [e.g., any of Hubs A or B, Fig.6], based on said access information included in the distribution request received by said first receiving portion from the one terminal device, and for receiving the distribution information accessed [col.5, lines 31-42; note that the low-resolution images are derived from high resolution images originated in the scanner stations];

a second storage portion storing said distribution information accessed and received by said second receiving portion [e.g., the low-resolution images are transmitted from Hub A, Fig. 6 to Hub B, Fig. 6 stored temporarily therein for subsequent distribution/download]; and

a first transmitting portion transmitting said distribution information stored in said second storage portion to the other terminal devices [col.5, lines 31-64; e.g., the distribution server pushes low resolution photographs to the mailboxes belonging to the terminals of the group) via each service provider's IP address, allowing each terminal device to download the images therefrom].

Sheridan does not specifically teach having a third receiving portion receiving a bill of charges from the content server billing charges for the distribution information when the distribution information is chargeable; and a second transmitting portion transmitting said bill of charges received by said third receiving portion either to the one terminal device having transmitted the distribution request or to a telecommunications carrier to which the one terminal device subscribes.

However, charging media content or related distribution services is well known in the art. In Sheridan's two Hubs scenario, Hub A is connected to the scanner where the original file is

submitted. Thus Hub A contains information that may include the film's low resolution image sets and user identification (col.5, lines 32-42). On the other hand, the user who makes the request (i.e., the requesting terminal) and other terminals of the granted group may also be connected to a different Hub (e.g., Hub B of Fig.6). As such, it would have been obvious to one of ordinary skill in the art to keep the billing information at the content server (i.e., Hub A, where the scanner is closely associated with), with charges sent to the Hub to which the requesting terminal (or the ISP of the requesting terminal) is connected because by doing so the billing record may always be kept to where the service is rendered. Note that this Hub-A/Hub-B scenario fits very well in a real situation where a tourist may drop off a film to a nearby scanner (e.g., connected to Hub A) during a trip and makes image distribution (via Hub B) to his/her friends after returning home.

11. As to claim 5, Sheridan further teaches transmitting notification, to the terminal device which transmitted said distribution request, of the fact that distribution has been completed, after the distribution of said distribution information by said first transmitting portion [col.6, lines 13-24].

12. As to claim 9, Sheridan further teaches that said first receiving portion receives said distribution request from said terminal device via another server device [note that Sheridan's system is inherently able to receive terminal device transmitted via an ISP server because Sheridan's system is tied to the Internet (205, Fig.1)].

13. As to claim 10, Sheridan further teaches that said distribution information is either a program including a game program, said program and a license for said program, map information, or product information [note that photograph is a product information].

14. As to claims 11, 14-15 and 18, since the features of these claims can also be found in claims 1, 5 and 9-10, they are rejected for the same reasons set forth in the rejection of claims 1, 5 and 9-10 above.

15. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheridan [U.S. Pat. No. 5760917], as applied to claims 1, 5, 9-11, 14-15 and 18, further in view of Official Notice.

16. As to claim 7, Sheridan does not specifically teach that said distribution request further includes a distribution time for specifying a time for distributing said distribution information, and said first transmitting portion distributes said distribution information at said distribution time.

However, Official Notice is taken that distributing information according to planned schedule is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users of Sheridan's system to specify timing constraint or delivery time as an option because such feature serves good customer service, in particular when distribution of certain photos is time-sensitive.

17. As to claim 13, since the features of this claim can also be found in claims 1, 7 and 11, it is rejected for the same reasons set forth in the rejection of claims 1, 7 and 11 above.

18. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19. Applicant's arguments filed on 4/23/09 for the rejected claims have been fully considered but they are not deemed to be persuasive.

20. (A) With respect to claims 21-22, 24-26, 28-29 and 31, Applicant argues that (1) Sheridan does not teach the function of the first terminal (e.g., 40A Fig.6) as described in the claims; (2) Sheridan fails to teach Hub station 20 does not perform function of the communication unit in the claims, which acquires distribution information from a content server and "push" the content to a plurality of second terminals.

(B) With respect to claim 1, Applicant argues that Sheridan teaches away the claimed feature of holding a bill of charges at the content server which should be sent to the Hub to which a terminal which sent a request for distribution of information belongs.

21. The examiner respectfully disagrees.

As to (A1) and (A2): Applicant is reminded that passage associated Fig. 6 (i.e., col. 13, lines 13-42) is merely an extension of Figs. 1, 2 or 4. Thus, the functionalities of the first

terminal and the Hus station to which the first terminal is connected are also described in passages associated with these other figures. For example, col. 4, lines 17-33 and col. 5, lines 19-64 have been cited over and over again in the previous office actions in the rejection of claim 1, etc. For example, the purpose of the two-Hub scenario as described at col. 13, lines 18-22 is:

“... a user can drop off a film for processing and scanning at any processor-scanner station which normally communicates with an associated hub, and automatically retrieve digital images at any terminal by communicating at another hub.”

Thus, all that is described at col. 4, lines 17-33 and col. 5, lines 19-64 also applies to the terminals and Hub 20 illustrated in Fig. 6

As to (A2): The push mode distribution has been clearly taught at col. 5, lines 35-42, wherein low-resolution images are distributed to recipients (in emails) designated by the image owner, without being requested from these designated recipients.

As to (B): Applicant is reminded that a service is normally not charged until it is completely rendered. In accordance with the scenario of Fig. 6, Sheridan teaches that a user may drop off a film at one scanner associated with Hub A (i.e., 21, Fig. 6), while requesting image distribution at a terminal associated with Hub B (i.e., 20, Fig. 6). It is true that billing should be originated from the scanner that renders the service and sent to the user who accesses it through another Hub. However, due to the fact that Sheridan's film scanners do not directly communicate with user terminals (as shown in Figs. 2, 4 and 6), each scanner has an associated Hub, with which lower resolution images are stored (col. 4, lines 34-47). For this reason, Hub A of Fig. 6 is referred to as a content server because it is associated the scanner where the film was dropped off and communicates the image content (to be distributed with emails) and billing information to Hub B, the latter being connected to service recipients.

For at least the above reasons, it is submitted that Sheridan reads on the claims as indicated in the office action.

22. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially

teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571)272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

July 17, 2009

/Wen-Tai Lin/

Primary Examiner, Art Unit 2454